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8 Otto 546
Oct. 9. 1878

TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

No. 947.

GEORGE HENDRIE, APPELLANT,

vs.

THOMAS SAYLES.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE EASTERN DISTRICT OF MICHIGAN.

FILED OCTOBER 24, 1878.

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INDEX.

	Original.	Print.
Bill of complaint	1	1
Subpœna	7	4
Precipe for appearance	11	5
Order for appearance and order for copy of bill	12	5
Amended bill of complaint	13	5
Notice of hearing for March term, 1878	34	21
Notice of hearing for June term, 1878	35	21
Proof of service of notice	36	22
do. do.	37	22
Stipulation	38	23
Order withdrawing answer and replication from files	39	23
Amendments to amended bill	40	23
Demurrer	42	24
Order overruling demurrer	45	25
Stipulation as to infringers' profits	46	25
Decree and claim of appeal and allowance, &c	47	26
Copy of bond on appeal	52	27
Clerk's certificate	54	28

1 Circuit Court of the United States in and for the Eastern District of Michigan.

THOMAS SAYLES
vs.
GEORGE HENDRIE. } In equity.

To the honorable the judges of the Circuit Court of the United States in and for the Eastern District of Michigan.

Thomas Sayles, of Chicago, in the State of Illinois, and a citizen of said state, brings this bill against George Hendrie, a resident of Detroit, in the eastern district of Michigan, and a citizen of the State of Michigan.

And thereupon your orator complains and says, that on or before the sixth day of July, eighteen hundred and fifty-two, Lafayette T. Thompson and Asahel G. Bachelder were the true, original, and first inventors of a certain new and useful improvement in railroad car-brakes, not known or used before their invention thereof, and not at their time of application for letters-patent therefor in public use or on sale with their consent or allowance.

And your orator further shows unto your honors that the said Lafayette T. Thompson and Asahel G. Bachelder, before the issuing of the letters-patent hereinafter mentioned, by an assign-
2 ment in writing sold, transferred, and assigned unto one Henry *Farmer*, of Buffalo, in the State of New York, all their right, title, and interest in and to their said invention, which assignment was duly recorded in the Patent Office of the United States, as by said assignment, or a duly authenticated copy thereof, and the certificate of such recording thereto affixed, ready in court to be produced, will fully and at large appear.

And your orator further shows unto your honors that the said Lafayette F. Thompson and Asahel G. Bachelder, being the inventors of said improvement, and being citizens of the United States aforesaid, made application to the proper department of the government of the United States for letters-patent for said invention, in accordance with the then existing laws of Congress, and having duly complied in all respects with the conditions and requisition of said laws, letters-patent of the United States, signed, sealed, and executed in due form of law, for said invention and discovery were issued to the aforesaid Henry *Parmer*, assignee as aforesaid, on the sixth day of July, eighteen hundred and fifty-two, whereby there was secured to the said Henry *Farmer*, his heirs, executors, administrators, or assigns, the full and exclusive right of making, using, and vending to others to be used the said improvement for the term of fourteen years from said sixth day of July, 1852.

And your orator further shows that a description or speci-
3 fication of the aforesaid improvement was given in the schedule to the said letters-patent annexed, accompanied by certain drawings referred to in said schedule, and forming part of said

letters-patent, as by said patent, or a duly authenticated copy thereof, in court to be produced, will fully appear.

Your orator further shows unto your honors that the legal representatives of said inventors being desirous of procuring an extension of the said letters-patent beyond the original term thereof, application was duly made therefor to the commissioner of patents, in accordance with the then existing laws of Congress, and having fully and in all respects complied with all the requirements of law in that behalf, such proceedings were had that the said commissioner of patents did extend the said letters-patent granted as aforesaid to said Farmer for the further term of seven years from and after the expiration of the original term thereof, that is to say, from and after the sixth day of July, 1866, of which extension said commissioner duly granted and issued a certificate, all of which will more fully appear by said original letters-patent, with the certificate endorsed thereon, or a certified copy thereof in court to be produced.

4 And your orator further shows unto your honors that a certain assignment in writing of certain rights in said invention and letters-patent was made and delivered to your orator and duly recorded in the Patent Office of the United States long before the expiration of the original term thereof, whereby your orator became, and during the remainder of said original term, and during the whole of said extended term of said patent, was the sole owner of said invention and letters-patent for, to, and in certain portions of the United States, including the State of Michigan, together with all rights and claims for damages as by said assignment or a duly authenticated copy thereof, and the certificate of such recording thereto affixed, here in court to be produced, will fully and at large appear.

And your orator further shows unto your honors that from the time of said assignment to him as aforesaid, until the expiration of said letters-patent, he was in the exclusive possession of the said improvements, patented as aforesaid, in and throughout the whole of the State of Michigan; and that said exclusive privilege to use said improvements, secured to your orator by virtue of said letters-patent and said assignment, were of great value to your orator.

And your orator further shows that a large number of railroad companies in the United States, both steam railroad companies and

5 city horse-railroad companies, have settled with your orator for the right to use the same, and have thereby recognized the validity of said letters-patent and said assignment.

And your orator further shows that heretofore the validity of said letters-patent has been affirmed both by verdicts and judgments at law thereon, and by decrees in equity in several of the circuit courts of the United States. And your orator further shows unto your honors, as he is informed and believes, that the defendant herein named, well knowing all the facts hereinbefore set forth, and during the said extension of the said letters-patent, and contriv-

ing how to injure your orator, and without the consent or allowance of your orator, and without any right, and in violation of said letters-patent and the exclusive rights secured to the said *Farmer* and to your orator as aforesaid, made or used or procured to be made and used within the said State of Michigan, the said patented improvement upon a large number of city horse-railroad cars belonging to or used by said defendant, said improvement so made and used by the defendant embracing substantially the improvement, or a material part thereof, patented as aforesaid, the exclusive right to make and use which and vend the same to others to be used, was by law vested in said *Farmer* and your orator as aforesaid, in said territory, and thereby the said defendant
6 infringed upon the exclusive rights and privileges secured to said *Farmer* and your orator as aforesaid.

Your orator further shows that he is unable to state upon how many cars, nor for how long a time the said defendant used said improvement in violation of said exclusive rights, but prays that the defendant may set forth and discover fully the whole number, as well as the number made or used each year. And your orator says that he has sustained damages in a large sum by reason of such infringement.

To the end therefore that the defendant may if he can show why your orator should not have the relief herein prayed, and may under oath make a full disclosure and discovery of all matters aforesaid, and full, true, direct, and perfect answer make, according to his best and utmost knowledge, remembrance, information, or belief, to each of the several interrogatories hereinafter numbered and set forth, as by the note hereinunder written they are required to answer, that is to say:

1. Whether the said letters-patent were granted and issued to the said Henry *Farmer*, and have been assigned as alleged.

2. Whether the validity of said letters-patent has been affirmed by the courts as alleged.

3. Whether the said defendant has at any time, and when and during what period of time, made, sold, or used any and
7 how many railroad car brakes constructed in whole or in part upon the principle and in the manner described in said letters-patent.

And that the said defendant may answer the premises and may be decreed to account for and pay over to your orator all gains and profits thus unlawfully derived from the violation of the rights of your orator as aforesaid, or of said Farmer, and all damages sustained thereby.

And that your orator may have such further and other relief in the premises as the equity of the case may require and to your honors may seem meet.

May it please your honors to grant unto your orator a writ of subpœna of the United States of America, directed to the said

George Hendrie and commanding the said defendant to appear and answer unto this bill of complaint and to abide and perform such order and decree in the premises, as may be made by the court.

GRIFFIN & DICKINSON,
Solicitors for Complainant.

The defendant is required to answer each of the foregoing interrogatories numbered 1, 2, 3.,

GRIFFIN & DICKINSON.
Solicitors for Complainant.

8 We hereby agree to become security for all costs to which complainant may become liable in within action.

(Signed) GRIFFIN & DICKINSON.

(Endorsed:) Filed Aug. 15, 1876. Jno. Graves, dy. clerk.

9 *Subpœna.*

Circuit Court of the United States of America for the Sixth Circuit and Eastern District of Michigan. Sitting in chancery.

The President of the United States of America to George Hendrie, of Detroit, who is a citizen of the state and resident of the eastern district of Michigan.

You are hereby commanded to be and appear in the Circuit Court of the United States of America for the Sixth Circuit and Eastern District of Michigan, sitting in chancery, before the judges thereof, at the district court-room in the city of Detroit, on the first Monday of September next ensuing, then and there to answer unto a bill of complaint exhibited against you as defendant by Thomas Sayles, of Chicago, Illinois, and a citizen of the State of Illinois, as complainant. And this you shall in no wise omit, under the penalty of one thousand dollars,

Witness the Hon. Morrison R. Waite, Chief Justice of the Supreme Court of the United States, this 15th day of August, in the year of our Lord one thousand eight hundred and seventy-six, and of the independence of the United States the one hundred and first.

ADDISON MANDELL, *Clerk*,
By JNO. GRAVES, *Depy.*

Memorandum.—The above-named defendant is required to enter his appearance in this suit with the clerk of this court, at his office in the city of Detroit, on or before the day to which this writ of subpœna is returnable, otherwise the bill of complaint in this cause will be take *pro confesso* against said defendant.

ADDISON MANDELL, *Clerk*,
By JNO. GRAVES, *Depy.*

10 (Endorsed:) No. 2,082. Circuit Court of the United States for the Sixth Circuit and Eastern District of Mich-

igan. In chancery. Thomas *Sayres* vs. George Hendrie. Subpœna. Returned and filed in clerk's office, Sept. 22d, 1876. Griffin & Dickinson, complainant's solicitors.

11 The United States States Circuit Court. In chancery.

THOMAS *Sayler*
vs.
GEORGE HENDRIE.

You will please enter the appearance of the defendant in the above-entitled cause by me, as his solicitor, and also an order therein that said complainant or his solicitors be required to furnish me with a copy of the bill of complaint, in accordance with the rules and practice of this court.

Dated Detroit, September 18th, 1876.

J. LOGAN CHIPMAN,
Solr. for Deft.

To clerk of said court.

12 Sept. 18, 1876.

THOMAS SAYLES, COMPLT.,
vs.
GEORGE HENDRIE, DEFT. } In equity.

On filing precipe in this cause, and on motion of J. Logan Chipman, solicitor for defendant, it is ordered that the appearance of said defendant by him, as his solicitor, be, and the same is hereby, entered.

And on like motion, it is further ordered that said complainant serve upon said defendant or his said solicitor a copy of the bill of complaint filed in this cause, within the time prescribed by the rules and practice of this court.

Entered by order of— J. LOGAN CHIPMAN,
Solr. for Deft.,
Per A. MANDELL, *Clk.*

13 (Endorsed on cover of amended bill of complaint:) U. S. Circuit Court, Eastern District of Michigan. In equity. Thomas Sayles versus George Hendrie. Amended bill of complaint and schedules annexed thereto. Griffin & Dickinson, solicitors for complainant. Filed Feb'y 13, 1877. A. Mandell, clk.

14 In the Circuit Court of the United States for the Eastern District of Michigan. In equity.

THOMAS SAYLES
versus
GEORGE HENDRIE.

To the judges of the Circuit Court of the United States for the Eastern District of Michigan.

Now comes the complainant, Thomas Sayles, of Chicago, Illinois, who is a citizen of the State of Illinois, and of the United States,

brings this his amended bill into this court, against George Hendrie, of Detroit, in the State of Michigan, and a citizen of said state.

15 And thereupon your orator complains and says, that in the year eighteen hundred and forty-six, and on and prior to the 6th day of July, A. D. eighteen hundred and fifty-two, Lafayette F. Thompson and Asahel G. Bachelder were citizens of the United States, and were jointly the true, original, and first inventors of a certain "improvement in railroad car brakes;" that at the time the said improvement was so invented by said Thompson and Bachelder, the same was new, and was then and is now highly useful, and was not known or used by others before the said invention thereof by the said Thompson and Bachelder, and was not at the time of their application for letters-patent of the United States therefor, in public use or on sale, with the consent and allowance of the said Thompson and Bachelder.

And your orator further shows unto your honors, that on or about the first day of April, eighteen hundred and fifty-two, and before the issuing of the letters-patent hereinafter set forth, the said Lafayette F. Thompson and Asahel G. Bachelder, by an instrument in writing, under their hands and seals, duly executed and delivered, and bearing date on said last-named day, did assign, sell, and set over to one Henry Tanner, of Buffalo, in the State of New York, who was then, and ever continued to be, a citizen of the United States, all the right, title, and interest whatever, which they then had, or by letters-patent would be entitled to have and possess, in the aforesaid invention; all of which will fully appear by reference to the said instrument, or to a copy thereof under the signature of the commissioner of patents, with the seal of the Patent Office of the United States affixed, which your orator brings here into court, and your orator shows that a copy of such certified copy of said instrument is hereunto annexed, marked "Schedule A," and your orator shows that the said instrument was duly recorded in the said Patent Office, on the fifteenth day of April, eighteen hundred and fifty-two.

And your orator further shows, that on the aforesaid sixth day of July, eighteen hundred and fifty-two, letters-patent for the said improvement were, in due form of law, issued and delivered

16 to the said Henry Tanner, in the name of the United States of America, and under the seal of the Patent Office of the United States, and signed by the Secretary of the Interior of the United States, and countersigned by the commissioner of patents, and that the said letters-patent did grant to the said Tanner, and to his heirs, administrators, or assigns, for the term of fourteen years from the last-named day, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement. And your orator brings here into court a copy of the said letters-patent, under the signature of the commissioner of patents, with the aforesaid seal affixed, and prays that the same

may be taken as a part of this bill, and he shows that a copy of such certified copy of said letters-patent is hereto annexed, marked "Schedule B."

And your orator further shows, that on or about the fifth day of July, eighteen hundred and sixty-six, the said Tanner patent was renewed and extended in due form of law, for the term of seven years from and after the sixth day of July, eighteen hundred and sixty-six, and that by virtue of said extension, the said Tanner patent had and has in law the same force and effect as though it had been originally granted for the full term of twenty-one years. And your orator brings here into court a copy of the certificate of such extension, under the signature of the aforesaid commissioner, with the seal of the said Patent Office affixed, and he prays that the same may be taken as a part of this bill, and he shows that a copy of such certified copy of said certificate is hereto annexed, marked "Schedule C."

And your orator further shows, that on or about the thirteenth day of July, eighteen hundred and fifty-four, the said Henry Tanner, by an instrument in writing, under his hand and seal, and duly executed and delivered, and bearing date on said last-named day, did sell, assign, transfer, and set over to your orator, the said Thomas Sayles, all his right, title, interest, and claim, both present and future, in and to said invention and patent, and any extension of the latter that might thereafter be granted, excepting certain territory set forth therein; all which will fully appear by reference to the last-mentioned instrument, or to a copy thereof under the signature of the aforesaid commissioner, with the aforesaid seal affixed, which your orator brings here into court, and your orator shows that a copy of such certified copy of said last-mentioned instrument is hereto annexed, marked "Schedule D;" and your orator shows that the last-mentioned instrument was duly recorded in the aforesaid Patent Office on the seventeenth day of July, eighteen hundred and fifty-four.

17 And your orator avers that the interest in the said Tanner patent, which was conveyed to him by the above-mentioned assignments, included, among other things, the entire right and property, in and to the aforesaid extended term of said Tanner patent within and throughout the whole extent of the territory or portion or portions of the United States wherein the hereinafter averred infringements and unlawful acts were committed; and your orator avers that by reason of the premises, your orator has become and now is the sole and exclusive holder of all rights of action for infringers' profits or savings, and for other relief, for or by reason of any and all infringements of the said Tanner patent, during the extended term thereof, committed at any time, by any corporations, partnerships, or persons, anywhere in the said territory, and that your orator is entitled to bring this suit.

And your orator further shows, that all the infringers of the said

Tanner patent, in all cases infringed the same either by making or using or vending car brakes in the form—or nearly in the form—shown in the drawings on page 15 of this printed bill of complaint, and which makes a part of the hereinbefore-mentioned "Schedule B;" or by making or using or vending car brakes in the form—or nearly in the form—shown on page 20 of this bill, and which is commonly known as the "Hodge" brake, (for which letters-patent of the United States were granted to one Nehemiah Hodge, on the 2d day of October, 1849, and reissued on the 1st day of March, 1853, as an alleged improvement upon all former methods of combining the brakes of the two trucks of a car so that the brakes of both trucks could be brought down simultaneously upon the wheels by the action of either windlass, and to which your orator craves leave to refer, should he desire to so, at the final hearing in
18 this suit); or by making or using or vending car brakes in the form—or nearly in the form—shown on page 20 of this bill, and which is commonly known as the "Stevens" brake, (for which letters-patent of the United States were granted to one Francis A. Stevens on the 25th day of November, 1851, as an alleged further improvement upon the aforesaid invention, and to which your orator craves leave to refer, should he desire to do so, at the final hearing in this suit); and your orator shows that the said Hodge brake and the said Stevens brake both contain and employ, and are necessarily founded upon, the combination of levers, rods, brakes, and windlasses, covered and patented by the said letters-patent of the said Tanner, and employ the mode of operation set forth in the said letters-patent, and are plain and palpable violations and infringements of the said Tanner patent; and that in an action at law heretofore brought by the said Tanner against the New York and Erie Railroad Company, for infringement of the said Tanner patent, it was decided in the verdict of the jury, duly enforced by the judgment of the court, that the aforesaid Stevens brake, and the aforesaid Hodge brake, used by the defendants, were infringements of the plaintiff's aforesaid patent, as by reference to the record of the verdict rendered in said action will fully appear, and your orator shows that a very large number, to wit, more than one hundred, of the railroad companies in the United States, purchased either of the said Tanner, or of your orator, and paid for, the right to use brakes constructed according to the said letters-patent of the said Hodge, or according to the said letters-patent of the said Stevens, and fully acknowledged that the said Hodge and Stevens brakes were infringements of the said Tanner patent, and also that the latter was good and valid.

And your orator further shows, that in an action in equity in the United States Circuit Court for the Northern District of Illinois, brought by your orator against the Chicago and Northwestern Railroad Company, in the year 1861, for infringement of the said Tanner patent, a final decree was entered December 22d, 1873, after

a very thorough and stubbornly contested litigation of nearly twelve years, in which decree it was among other things ordered and adjudged as follows:

"That the letters-patent on which this suit is brought, granted on the sixth day of July, A. D. eighteen hundred and fifty-two, to Henry Tanner, as the assignee of Asahel G. Bachelder and Lafayette F. Thompson, for an improvement on railway car brakes, are good and valid.

"That the said Asahel G. Bachelder and Lafayette F. Thompson were jointly the original and first inventors of the combination of the brakes of a railroad car with the operative windlasses, so that the brakeman, by operating either windlass, can apply all the brakes of the car simultaneously to the wheels of the car.

"That the said Bachelder and Thompson never neglected
19 or abandoned the said invention, and that the said Henry Tanner, by the grant of the said letters-patent, became and was vested with the sole and exclusive right and liberty of making, using, and selling to others to be used, the said invention throughout the United States, for the term for which the said letters-patent were granted.

"That the said letters-patent properly and sufficiently describe and claim the invention of the said Bachelder and Thompson, and that the aforesaid thing patented and covered in and by the said letters-patent, is the combination of all the brakes of a railroad car with the operative windlasses on the car, so that the brakeman, by operating either of these windlasses, can apply simultaneously all the brakes to the wheels of the car.

"That the car brake known as the 'Stevens' brake, used by the defendants in this cause, embodies and contains the aforesaid combination patented and covered in and by the said letters-patent, on which this suit is brought, granted to the aforesaid Henry Tanner as assignee as aforesaid, on the sixth day of July, A. D. eighteen hundred and fifty-two.

"That the said defendants, the said The Chicago and Northwestern Railroad Company, by the use of the said 'Stevens' car brake, have violated and infringed upon the rights of the complainant under the said letters-patent," as by reference to the record of said decree will fully appear.

And your orator further shows, that the said improvement of Thompson and Bachelder is now, and for many years has been, in constant use upon almost every railroad in the United States, and that the rights of action existing under the said Tanner patent, and under the extension thereof, against corporations, partnerships, and persons, who were infringers thereof, are of very great value; and that the above-named *defendant*, well knowing the premises, but contriving to injure your orator, and to deprive him of the gains, profits, savings, benefits, and advantages which might and otherwise would have accrued to him from the said Tanner patent, and the said ex-

tension thereof, did from the sixth day of July, 1866, and up to *and including* the sixth day of July, 1873, unlawfully and wrongfully, and without the license or permission of your orator, and against the will of your orator, use and operate, or cause or permit to be used and operated, upon railroad cars within the district aforesaid, brakes and brake mechanisms for railroad cars, containing and employing substantially the improvement, or some part thereof, patented in and by the said letters-patent of the said Tanner, in violation and infringement of the said exclusive rights and privileges of your orator; but how many such brakes for railroad cars the
20 *defendant* so used and operated, or caused or permitted to be used and operated, your orator is ignorant and cannot set forth; but your orator avers that the *defendant* so used and operated, or caused or permitted to be used and operated, a large number thereof, and that he derived, received, and realized therefrom great gains, profits, savings, benefits, and advantages, but to what amount your orator is ignorant and cannot set forth, and he prays that the *defendant* may be required to make a discovery of the full number of brakes, and full amount of gains, profits, and savings.

And your orator further shows that he has sustained damages to a large amount by reason of said infringement.

21 And your orator further prays that the defendant by a decree of this court may be compelled to account for and pay to your orator all the gains, profits, and savings which the *defendant* at any time during the first term or the extended term of the said Tanner patent, in any manner derived, received, or realized from or by reason of the use and operation in brakes for railroad
22 cars, of the improvement patented thereby; and also that the *defendant* may be decreed to pay the costs and disbursements of this suit; and that your orator may have such further or other relief as the equity of the case may require, and to this court may seem meet.

To the end, therefore, that the *defendant* may, if he can, show why your orator should not have the relief hereby prayed, and may (under *oath*), according to the best and utmost of his knowledge, remembrance, information, or belief, full, true, direct, and perfect answer make to the several matters hereinabove stated, as fully and particularly as if the same were here repeated and the *defendant* specially interrogated with reference thereto respectively; and especially that he may such perfect answer make to such of the several interrogatories hereinafter numbered and set forth, as by the note hereunder written he is required to answer; that is to say —

1. Whether, after the said sixth day of July, 1866, and up to *and including* the said sixth day of July, 1873, he used and operated, or caused, or permitted to be used and operated within the district aforesaid, or elsewhere in the United States, any brakes for railroad cars, which were so constructed and contained such a combination of parts and mode of operation as to enable the brakeman, by oper-

ating either of the windlasses, to simultaneously apply the brakes of both trucks, or bring or force them against their respective wheels, and whether he be at the forward or rear end of the car; and when and where and upon what railroad or railroads, or parts or
23 branches thereof, the same have been so used, and how many of such brakes for railroad cars the *defendant* used and operated, or caused, or permitted to be used and operated.

2. And whether the *defendant* claims that the same were so used and operated, or caused, or permitted to be used and operated, under or by reason or color of any license or any other permission or authorization from any person or persons whatever, and if so, that ——— may fully set forth any such license or other authorization.

May it please your honors to grant unto your orator a writ of *subpœna ad respondendum* issuing out of and under the seal of this honorable court, directed to the said George Hendrie, and commanding him to appear and make answer to this bill of complaint, and to perform and abide by such order and decree herein as to this court shall seem just.

And your orator will ever pray.

GRIFFIN & DICKINSON,
Solicitors for Complainant.

ALBERT H. WALKER, *of Counsel.*

24 The defendant is required to answer the interrogatories numbered respectively 1, 2.

GRIFFIN & DICKINSON,
Solicitors for Complainant.

25 SCHEDULE A.

Whereas, we, Lafayette F. Thompson, of Charlestown, and Asahel G. Bachelder, now or late of Lowell, in the State of Massachusetts, have invented an improved mode of operating the brakes of railway cars, and have applied, or intend to apply, for letters-patent of the United States of America, therefor.

Now, therefore, this indenture witnesseth, that for and in consideration of one hundred dollars, in hand paid, the receipt whereof is hereby acknowledged, I have assigned and set over, and do hereby assign, sell, and set over to Henry Tanner, of Buffalo, in the State of New York, all the right, title, and interest whatever, which we now have, or by letters-patent would be entitled to have and possess, in the aforesaid invention; the said invention being described in the specification as prepared and executed by us, or to be prepared and executed by us, for the obtaining of said letters-patent; the whole to be enjoyed and held by the said Henry Tanner and his legal representatives, to the full extent and manner in which the same would have been or could be held and enjoyed by us had this assignment never been made.

And we do, by these presents, authorize the Commissioner of Patents to issue the said letters-patent to the said Henry Tanner and his legal representatives, as the assignee of our whole right and title to the same and to the new invention aforesaid.

In witness whereof, we have hereto set our signatures and seals, this first day of April, A. D. 1852.

LAFAYETTE F. THOMPSON. [SEAL.]
ASAHEL G. BACHELDER. [SEAL.]

Witness: R. H. EDDY.

26 SCHEDULE B.

No. 9,109. UNITED STATES OF AMERICA.

To all to whom these letters-patent shall come:

Whereas, Lafayette F. Thompson, of Charlestown, Mass., and Asahel G. Bachelder, of Lowell, Mass., have alleged that they have invented a new and useful improvement in railroad car brakes, (they having assigned their right, title, and interest in said improvement to Henry Tanner, of Buffalo, N. Y.,) which they state has not been known or used before their application; have made oath that they are citizens of the United States; that they do verily believe that they are the original and first inventors or discoverers of the said improvement, and that the same hath not, to the best of their knowledge and belief, been previously known or used; have paid into the treasury of the United States the sum of thirty dollars, and presented a petition to the Commissioner of Patents, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose.

These are therefore to grant according to law to the said Henry Tanner, his heirs, administrators, or assigns, for the term of fourteen years from the sixth day of July, one thousand eight hundred and fifty-two, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said Thompson and Bachelder in the schedule hereunto annexed, and is made a part of these presents.

In testimony whereof, I have caused these letters to be made patent, and the seal of the Patent Office has been hereunto affixed.

Given under my hand at the city of Washington, this sixth day of July, in the year of our Lord one thousand eight hundred and fifty-two, and of the independence of the United States of America the seventy-seventh.

ALEX. H. H. STUART,
Secretary of the Interior.

Countersigned and sealed with the seal of the Patent Office.
[L. S.]
THOS. EWBANK,
Commissioner of Patents.

The schedule referred to in these letters-patent and making part of the same:

To all persons to whom these presents shall come:

Be it known, that we, Lafayette F. Thompson, now or late of Charlestown, and Asahel G. Bachelder, of Lowell, in the county of Middlesex, and State of Massachusetts, have invented a new and useful mode of operating the brakes of railway cars, and we do hereby declare that the same is fully described and represented in the following specification and the accompanying drawings, letters, figures, and references thereof.

27 Of the said drawings, figure 1 denotes a top view of the platform frame of a long car, resting on two truck frames, the same also exhibiting our invention, as applied to the brakes of the wheels of its two truck frames. Figure 2 is a side elevation; and figure 3 a vertical, central, and longitudinal section of the same. In the said drawings, A denotes the platform of an eight-wheeled car resting on two truck frames, B, C.

D, D^1, E, E^1, are the wheels of one truck frame, while F, F^1, G, G^1, are those of the other truck frame. H, I, K, L, are the axles, while M, N, O, P, are the four sets of brakes applied to the wheels. Each set of brakes is connected to a vibrating lever, Q, R, S, or T, which enables the set of brakes to swing either towards or away from their respective sets of wheels. In the above-mentioned drawings, the fulcra of these levers are at their upper ends, as seen at *a*, *a*, etc. Under the middle of the car platform I arrange a lever, A^1, that turns horizontally on a center pin, B^1.

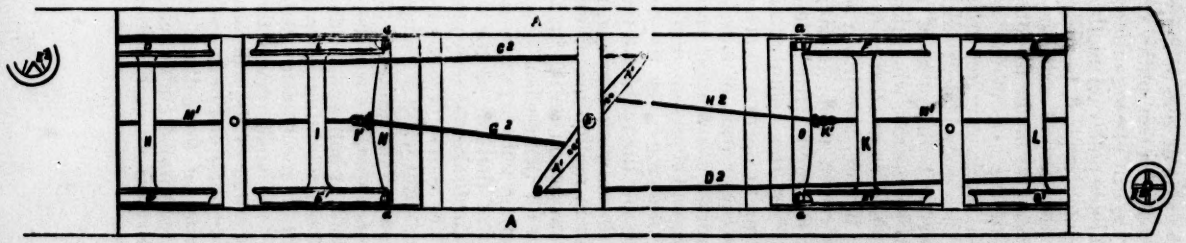
A rod, C^2 or D^2, or its equivalent, is jointed to each end of the lever, A^1, and is extended from thence towards the end of the car, one rod being extended towards one end, while the other is carried towards the opposite end. Each rod is attached to a cord or chain, b^1, at its end, that is wound on the barrel of a windlass, E^2 or F^2, fixed on the adjacent end of the platform, there being one windlass at each end of the platform.

Between the fulcrum of the lever, A^1, and each rod, C^2, D^2, there is another rod or chain as seen at G^2, H^2, which is jointed at one end of the lever, A^1, and has its other end jointed to the upper arm of one of two secondary levers, I^1, K^1. The lower end of the lever, I^1, is jointed to the set of brakes, N, while the lower end of the lever, K^1, is similarily jointed to the set of brakes, O. Rods, M^1, N^1, are respectively jointed to the secondary levers between their lower and upper ends, and extend therefrom and are jointed at their opposite ends to the set of brakes, M, P. Under such circumstances, if a person rotates either windlass, E^1 or F^1, so as to wind up its chain, he will produce a draft on the lever, A^1, that will cause all the brakes to simultaneously close down on their respective sets of wheels.

From the above it will be seen that a brakeman at either end of the car, by simply turning the windlass at such end, can simultaneously operate, or make bear against their wheels, all the sets of brakes. Our improvement can readily be applied to sets of brakes arranged between the wheels, as well as to those where the brakes clasp each wheel on its two opposite sides.

The principle of arresting or retarding the progress of two or more cars while in motion on a railway, by the momentum of one or more of them being made to act on the friction brakes of said cars, through the intervention of any suitable mechanism combined with the bumpers and the brakes, or the combination of the brakes and bumpers, and a mechanism that will enable the momentum of one or more of the cars, acting against the bumpers, to force the brakes against the wheels, is not herein claimed; nor is it herein claimed to apply such momentum for such purpose by a mode wherein the brake apparatus is so combined

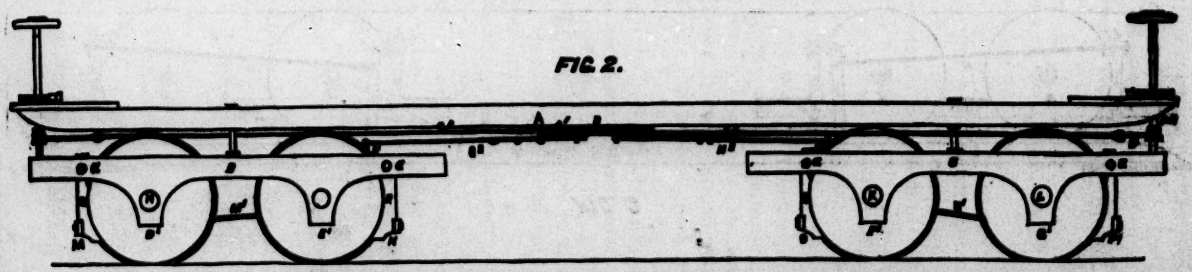
FIG. 1



HENRY TANNER, ASS. OF LAFAYETTE F. THOMPSON AND ASAHEL G. BACHELDER'S
IMPROVED BRAKE FOR RAILWAY CARS.

Patented July 6th, 1852.

FIG. 2.



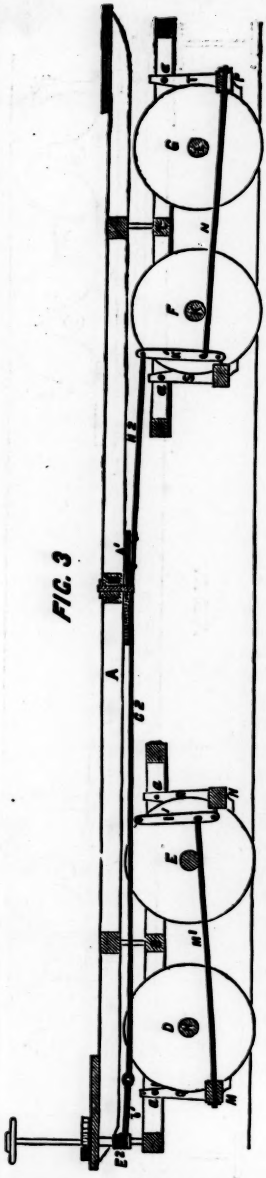


FIG. 3

29 with the axle of one of the wheels by means of a fast pulley on such axle, an endless belt passing around such pulley, and a loose pulley on another axle or shaft, a clutch applied to such loose pulley and the second axle or shaft, whereby it may be made to rotate by the rotation of the axle of the wheels, and finally a mechanism or apparatus connecting the second shaft with the brakes of one or both trucks of a car, and made to so operate when the loose pulley is clutched to its shaft as to cause the brakes to be forced or drawn against the wheels, for such mode (it being that invented by George S. Griggs, and patented December 31st, 1839) of causing the momentum to operate to arrest the velocity of a car or train of cars, differs essentially from the invention hereinbefore set forth, and represented in the accompanying drawings; for the friction of the wheels on the rails, and the momentum of the moving carriage, is employed to put in motion machinery that is brought into action on the brakes, or caused to act on them when connected with the rotating pulley, put in motion by the pulley of the axle of the wheels, the attendant or brakeman only performing the office of moving the sliding part of the clutch. But what is claimed by us is to so combine the brakes of the two trucks with the operative windlasses, or their equivalent, at both ends of the cars, by means of the vibrating lever, A^1, or its equivalent, or mechanism essentially as specified, as to enable the brakeman, by operating either of the windlasses, to simultaneously apply the brakes of both trucks, or bring or force them against their respective wheels, and whether he be at the forward or rear end of the car.

In testimony whereof, we have hereunto set our signatures, this eighth day of April, A. D. 1852.

A. G. BACHELDER.
LAFAYETTE F. THOMPSON.

Witnesses—
DANIEL S. RICHARDSON,
NAHUM LEONARD, JR.,
To A. G. Bachelder.

P. C. TRUMAN,
MILOW C. MCCLURE,
To Lafayette F. Thompson.

30 SDHEDULE C.

Whereas, upon the petition of George O. Way, of Claremont, Minnesota, administrator of the estate of Layfayette F. Thompson, deceased, and Asahel G. Bachelder, of Lowell, Massachusetts, for the extension of the patent granted to Henry Tanner, assignee of said Thompson and Bachelder, July 6, 1852, the undersigned, in accordance with the 18th section of the act of Congress, approved the 4th day of July, 1836, entitled "An act to promote the progress of the useful arts and to repeal all acts and parts of acts heretofore made for that purpose," and the act approved the 27th day of May, 1848, entitled "An act to provide additional examiners in the Patent Office," and for other purposes, did on this 5th day of July, 1866, decide that the said patent ought to be extended:

Now, therefore, I, Thomas Harland, Acting Commissioner of Patents, by virtue of the power vested in me by said act of Congress, do renew and extend the said patent, and certify that the same is hereby extended, for the term of seven years from and after the expiration of the first term, viz: From the 6th day of July, 1866; which certificate being duly entered of record in the Patent Office, the said patent has now the same effect in law as though the same had been originally granted for the term of twenty-one years.

And it appearing, from the evidence on file in this office, that the original of said patent cannot now be produced, it is directed that this certificate of extension be entered on a certified copy of said patent.

In testimony whereof, I have caused the seal of the Patent Office to be hereunto affixed, this 5th day of July, 1866, and of the independence of the United States the ninety-first.

[L. S.] THOMAS HARLAND,
Acting Commissioner.

31 SCHEDULE D.

Whereas, letters-patent were granted to Henry Tanner, of Buffalo, county of Erie, and State of New York, by the United States government, bearing date July 6, 1852, for an improvement in a railroad car brake, on an application made therefor by L. F. Thompson and A. G. Bachelder, of Massachusetts, and duly assigned to the said Tanner; and

Whereas, Thomas Sayles, of Lansingburg, in the State of New York, has this day purchased of the said Henry Tanner all his remaining right, title, and interest in and to said patent for said improvement in railroad car brakes, for the unexpired term thereof, and for any extension that may be granted therefor, excepting the following reserved territory and railroad corporations, to wit:

All of the States of Ohio, Indiana, and Illinois, excepting the Illinois Central railroad, which is hereby sold to said Sayles, and reserving unsold, further, the Michigan Central railroad, and the Michigan Southern and Northern Indiana railroad, and the Ohio and Mississippi railroad, and the Louisville and Nashville Railroad, the horse railroad round the Ohio Falls, from Louisville to Portland, about three miles, more or less, and Louisville and Frankfort railroad. Also the Hudson River railroad; also the New York Central railroad; also Rensselaer and Saratoga railroad; also Saratoga and Washington railroad; also the New York and New Haven railroad; also New York and Harlem railroad; also Housatonic railroad; also Baltimore and Ohio railroad; also Baltimore and Susquehanna railroad; also Elmira and Canandaigua railroad; also Canandaigua and Niagara Falls railroad; also Buffalo and State Line railroad; also Fitchburg railroad; also Boston and Worcester railroad; also Western Vermont railroad; also Cheshire railroad; also the Concord railroad; also the Troy and Boston railroad; also the Worcester and Nashua railroad; also the Eastern railroad; also the Boston and Maine railroad; also the Canal railroad; also the South Shore railroad; also the Richmond and Petersburg railroad; also the Vermont Valley railroad; also the Portland, Saco and Portsmouth railroad; also Boston and Lowell railroad; also Boston and Providence railroad; also the Old Colony railroad; also the Providence and Worcester railroad; also the New London, Wilimantic and Palmer railroad; also the Stonington and Providence railroad; also the New Haven, Hartford and Springfield railroad; also the Buffalo and New York City railroad; also the Buffalo, Corning and New York railroad; also the Erie and North East railroad; and has paid me the just and full sum twenty-five thousand dollars, for the territory hereby sold, the receipt whereof is hereby acknowledged before the delivery of this deed.

Now know, therefore, all men by these presents, that I, the said Henry Tanner, have sold, and by these presents do hereby sell, assign, transfer, and set over to the said Thomas Sayles all my right,

title, and interest and claim whatsoever, which I have, or may have, in and to said invention and patent, and any extension thereof that may hereafter be granted, excepting the territory above
32 reserved, by reason of said letters-patent or otherwise; giving and granting to the said Sayles and his legal representatives, the full power to make, use, vend and sell to others to make, use, and vend the said invention, in all cases as fully and freely as I might or could have done had this bargain and sale not have been made; and the said Henry Tanner doth hereby covenant to and with the said Thomas Sayles, that he is now the lawful owner and holder of the said letters-patent, and that he has not sold to any person, or persons, whomsoever, or to any corporations, any interest in said letters-patent, or in anywise to vend the improvement aforesaid, except as herein above mentioned.

Witness my hand and seal, at the city of Albany, this thirteenth day of July, A. D. 1854.

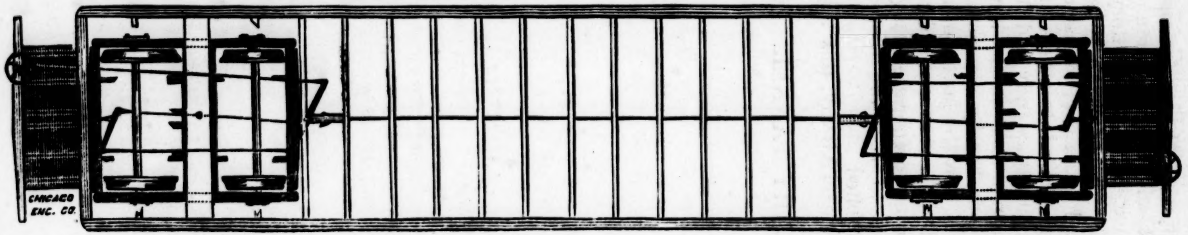
HENRY TANNER. [SEAL.]

In presence of—

A. EMIGH.

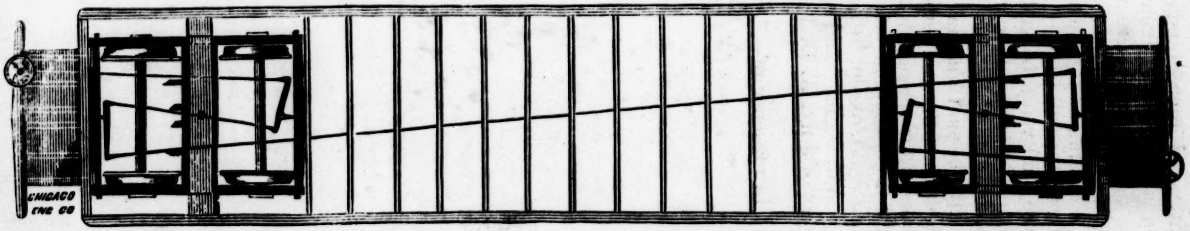
Hodge Brake.

Patented Oct. 2, 1849. Expired Oct. 2, 1870.



Stevens Brake.

Patented Nov. 25, 1851. Expired Nov. 25, 1872.



34 UNITED STATES OF AMERICA,
EASTERN DISTRICT OF MICHIGAN.

In the Circuit Court of the United States for the Eastern District of Michigan. In equity.

Dated the 16th day of February, 1878.

THOMAS SAYLES
vs.
GEORGE HENDRIE.

The above-entitled cause will be brought on for hearing at the next term of this court, notice having been served on the part of complainant on J. Logan Chipman, esq., solicitor for the defendant, according to the statute and rules of this court. You will please place said cause on the docket of this court for said term.

GRIFFIN & DICKINSON,
To the clerk of said court. *Solicitors for Compt.*

(Endorsed:) Filed Feby. 16, 1878. A. Mandell, clk.

35 UNITED STATES OF AMERICA,
EASTERN DISTRICT OF MICHIGAN.

In the Circuit Court of the United States for the Eastern District of Michigan. In equity.

Dated the 14th day of May, 1878.

THOS. SAYLES
vs.
GEORGE HENDRIE.

The above-entitled cause will be brought on for hearing at the next term of this court, notice having been served on the part of the complainant on J. Logan Chipman, solicitor for the defendant, according to the statute and rules of this court. You will please place said cause on the issue docket of this court for said term.

GRIFFIN & DICKINSON,
To the clerk of said court. *Solicitors for Complainant.*

(Endorsed:) Filed May 14, 1878. A. Mandell, clerk.

36 UNITED STATES OF AMERICA,
EASTERN DISTRICT OF MICHIGAN.

In the Circuit Court of the United States for the Eastern District of Michigan. In equity.

Dated the 16th day of February, 1878.

THOMAS SAYLES
vs.
GEORGE HENDRIE.

SIR: Take notice, that the above-entitled cause will be brought

on for hearing at the next term of said court, to be held at the court-house in Detroit, and district aforesaid.

Yours, etc., GRIFFIN & DICKINSON,
Solicitors for Complainant.

To J. LOGAN CHIPMAN, esq.,
Solicitors for Defendant.

UNITED STATES OF AMERICA,
EASTERN DISTRICT OF MICHIGAN, } *ss.*
COUNTY OF WAYNE.

Edward E. Payette, being duly sworn, deposes and says, that on the 16th day of February, 1878, he served a notice, of which the within is a true copy, on J. Logan Chipman, solicitor for the defendant in the above-entitled cause, by handing the same to Mr. Chipman in person. EDWARD E. PAYETTE.

Subscribed and sworn before me, this 16th day of February, A. D. 1878. SAMUEL J. KILSO,
Notary Public, Wayne Co., M.

(Endorsed:) Filed February 16, 1878. A. Mandell, clerk.

37 UNITED STATES OF AMERICA,
EASTERN DISTRICT OF MICHIGAN.

In the Circuit Court of the United States. In equity.

Dated the 14th day of May, 1878.

THOS. SAYLES
vs.
GEORGE HENDRIE.

SIR: Take notice, that the above-entitled cause will be brought on for hearing at the next term of said court, to be held at the court-house in Detroit, and district aforesaid.

Yours, etc., GRIFFIN & DICKINSON,
Solicitors.

To J. LOGAN CHIPMAN, esq.,
Solicitor for Defendant.

UNITED STATES OF AMERICA,
EASTERN DISTRICT OF MICHIGAN. } *ss.*

Fred. B. Low, being duly sworn, deposes and says, that on the 14th day of May, 1878, he served a notice, of which the within is a true copy, on J. Logan Chipman, sol'r for the defent. in the above-entitled cause, by handing the same to Mr. Banbie, who accepted service of the same. FRED. B. LOW.

Subscribed and sworn to before me, this 14th day of May, A. D. 1878. M. MANDELL,
U. S. Commissioner Eastern Dist. of Michigan.

(Endorsed:) Filed May 14, 1878. A. Mandell, clerk.

38 In the United States Circuit Court for the Eastern District of Michigan.

THOMAS SAYLES
vs.
GEORGE HENDRIE. } In equity.

It is hereby stipulated as follows by and between the parties to the above entitled cause:

First. The replication and the answer heretofore filed in the said cause shall be withdrawn.

Second. The said complainant may amend his amended bill instanter.

Third. The said defendant may file a demurrer instanter to the said amended bill as amended.

GRIFFIN & DICKINSON,
Solrs. for Comp.
ALBERT H. WALKER,
Of Counsel for Comp.
GEO. H. LOTHROP,
Solr. for Deft.

39 At a session of the Circuit Court of the United States for the Eastern District of Michigan, continued and held pursuant to adjournment, at the district court-room, in the city of Detroit, on Monday, the first day of July, in the year one thousand eight hundred and seventy-eight.

Present, Honorable Henry B. Brown, district judge.

THOMAS SAYLES, COMPLAINANT,
2,082. *vs.*
GEORGE HENDRIE, DEFENDANT. } In equity.

On reading and filing stipulation in this cause it is ordered that the replication and answer heretofore filed in this cause be withdrawn; that said complainant may amend his amended bill instanter, and that the said defendant may file a demurrer instanter to the said amended bill as amended.

40 In the Circuit Court of the United States for the Eastern District of Michigan.

THOMAS SAYLES
vs.
GEORGE HENDRIE. } In equity.

Amendments to the amended bill of complaint in this cause, made pursuant to an order of court, entered on the first day of July, 1878.

First. After the 28th line of the 2nd page of said bill, i. e., after the 3d paragraph of said bill, insert the following:

And your orator further shows that on the said first day of April, 1852, and at the time the said assignment was delivered as afore-

said, and as the whole of the actual consideration therefor, an agreement in writing was entered into by the said Tanner as party of the one part, and the said Bachelder and the said Thompson as party of the other part, which provided that the said Tanner should retain for his services and expenses connected therewith one-fourth of the entire gross proceeds of all his sales of rights to make, use, or vend the said improvement, and should retain further out of said
41 proceeds enough to pay the cost of any litigation which might arise in the matter, and should pay over to the said Bachelder and Thompson one-half of the balance of all said gross proceeds.

Second. After the 12th line of the 3rd page of the said bill, that is, after the fourth paragraph of the bill, insert the following:

And your orator further shows that the said Tanner and the said Bachelder and Thompson did, after the execution of the said assignment of April 1st, 1852, and prior to the hereinafter mentioned assignment of the thirteenth day of July, 1854, and after the said last-named day, and prior to the fifth day of July, 1866, by the performance of certain acts of them respectively done, practically construe the said assignment of April first, 1852, and that the practical construction so placed by the said Tanner, and by the said Bachelder, and by the said Thompson, was and is to the effect that the said assignment conveyed, and operated to convey, to the said Tanner not only the first term of the said letters-patent, but also the entire legal title to any extension of the same.

GRIFFIN & DICKINSON,
Solicitors of Complt.
ALBERT H. WALKER,
Of Counsel for Complt.

(Endorsed:) Filed July 1, 1878. (Sigd.) Jno. Graves, dep. clk.

42 In the Circuit Court of the United States for the Eastern District of Michigan. In equity.

The demurrer of George Hendrie, defendant, to the amended bill of complaint of Thomas Sayles, complainant.

This defendant, by protestation not confessing or acknowledging all or any of the matters and things in the said complainant's bill to be true in such manner and form as the same are therein set forth and alleged, doth demur thereto, and for cause of demurrer showeth that the said complainant hath not in and by his said amended bill made or shown any such title in himself to the extended term of the letters-patent set forth in said amended bill, as doth or ought to entitle him to any such discovery or relief as is thereby sought and prayed for from or against this defendant; wherefore this defendant demands the judgment of this honorable court whether he shall be compelled to make any other or further answer to the said amended bill or any of the matters and things

therein contained, and prays to be hence dismissed with his reasonable costs in this behalf sustained.

GEO. H. LOTHROP,
Sol'r for Defend.

J. LOGAN CHIPMAN,
of Counsel.

43 (Endorsed:) Filed May 1st, 1878. (Sig'd) Jno. Graves, dep'y clk.

44 At a session of the Circuit Court of the United States for the Eastern District of Michigan, continued and held pursuant to adjournment, at the district court-room, in the city of Detroit, on Tuesday, the second day of July, in the year one thousand eight hundred and seventy-eight.

Present, Honorable Henry B. Brown, district judge.

THOMAS SAYLES, COMPLAINANT,
2,082 *vs.* } In equity.
GEORGE HENDRIE, DEFENDANT.

The demurrer of defendant to complainant's bill of complaint now coming on to be heard, is argued by counsel for the respective parties and submitted.

45 At a session of the Circuit Court of the United States for the Eastern District of Michigan, continued and held pursuant to adjournment, at the district court-room, in the city of Detroit, on Wednesday the seventeenth day of July, in the year one thousand eight hundred and seventy-eight.

Present, Hon. Henry B. Brown, district judge.

THOMAS SAYLES, COMPLT.,
2,082 *vs.* } In equity.
GEORGE HENDRIE, DEFT.

The demurrer in this cause having been heretofore argued and submitted, and the same having been duly considered, it is ordered that the same be and is hereby overruled.

46 In the United States Circuit Court, Eastern District of Michigan.

THOS. SAYLES
vs. } In equity.
GEORGE HENDRIE.

In order to save the expense of a reference of the above-entitled cause to a master in chancery to ascertain and report an account of infringers' profits, it is hereby stipulated by and between the parties thereto, that the said defendant did, from the sixth day of July, 1866, and up to the sixth day of July, 1870, derive, receive, and realize profits amounting to five hundred dollars from his unlawful use in the city of Detroit, Michigan, of the invention covered and

secured by letters-patent of the United States, number 9,109, granted to Henry Tanner, July 6th, 1852, and extended July 5, 1866, for seven years from and after July 6th, 1866.

ALBERT H. WALKER,
Of Counsel for Compl.
GEO. H. LOTHROP,
Solc. for Deft.

(Endorsed:) Filed Aug. 14, 1878. A. Mandell, clk.

47 In the United States Circuit Court, Eastern District of Michigan.

THOS. SAYLES
vs.
GEORGE HENDRIE. } In equity.

This cause having heretofore been argued on the defendant's demurrer to the complainant's amended bill of complaint as amended, before the Hon. Henry B. Brown, one of the judges of said court, by George H. Lothrop, esq., solicitor for the said defendant, and Albert H. Walker, of counsel for said complainant, and the said judge having decided that said demurrer ought to be overruled, and an order having been accordingly entered of record in said court overruling the same, and the said defendant, by George H. Lothrop, esq., his solicitor, having elected to stand by his said demurrer, and having consented in open court that the said amended bill, as amended, may be taken against him *pro confesso*, as for want of an answer, and that the matter thereof may be decreed against him, and a stipulation of the parties to the said cause having
48 been filed in said court, in which stipulation it is agreed by and between the said parties that the said defendant did, from the sixth day of July, eighteen hundred and sixty-six, and up to the sixth day of July, eighteen hundred and seventy-three, derive, receive, and realize profits amounting to five hundred dollars from his unlicensed use, in the city of Detroit, Michigan, of the invention covered and secured by letters-patent of the United States, number 9,109, granted to Henry Tanner, July 6th, 1852, and extended July 6th, 1866, for seven years from and after July 6th, 1866.

Now, therefore, it is hereby ordered, adjudged, and decreed herein as follows:

First. That on and prior to the said sixth day of July, eighteen hundred and fifty-two, Lafayette F. Thompson and Asahil G. Bachelder were citizens of the United States, and were jointly the true, first, and original inventors of the improvement in railroad car brakes covered and secured by the said letters-patent.

Second. That the said letters-patent, and the certificate of
49 extension thereof, upon which this suit is brought, and which

are set forth in full in Schedules B and C annexed to said amended bill, are good and valid.

Third. That under and by virtue of the instrument in writing of April 1st, 1852, referred to in said amended bill, and set forth verbatim in Schedule A, annexed thereto, the said Henry Tanner acquired from the said Lafayette F. Thompson and the said Asahel G. Bachelder, the legal title to both the original and the extended term of said letters-patent.

Fourth. That under and by virtue of the instrument in writing of July thirteenth, 1854, referred to in said amended bill and set forth verbatim in Schedule D, annexed thereto, the said complainant, the said Thomas Sayles, acquired from the said Henry Tanner, the *the* legal title to the said letters-patent for both the *the* original and the extended terms thereof in and throughout sundry portions of the territory of the United States, including the city of Detroit, Michigan.

50 *Fifth.* That by virtue of the said instruments in writing, the said complainant, the said Thomas Sayles, has become and now is the lawful holder of all rights of action for infringers' profits, derived, received, or realized, by any person, from the unlawful use in the city of Detroit aforesaid, of the said invention covered by the said letters-patent during the said extended term thereof.

Sixth. That the said defendant, the said George Hendrie, did, in the city of Detroit aforesaid, and from the sixth day of July, eighteen hundred and sixty-six, and up to the sixth day of July, eighteen hundred and seventy-three, unlawfully use the invention aforesaid.

Seventh. That the said defendant, the said George Hendrie, derived, received, and realized from said unlawful use, certain profits to the amount of five hundred dollars.

Eighth. That the said complainant do recover of the said defendant the amount so received and realized by him, that is to say, the sum of five hundred dollars, and that the complainant have execution therefor.

51 And thereupon the defendant, by his solicitor, prays an appeal to the Supreme Court of the United States, which is allowed by the court upon bond being given according to law.

(Sig'd.)

Passed, signed, entered, and filed, Aug. 14, 1878. A. Mandell, clerk.

52 Know all men by these presents, that we, George Hendrie, principal, and Sidney D. Miller, as surety, both of Detroit, Wayne county, Michigan, are held and firmly bound unto Thomas Sayles, of Chicago, Illinois, in the sum of one thousand dollars, lawful money of the United States of America, to be paid to the said Thomas Sayles or his certain attorney, heirs, administrators, or

assigns, to which payment well and truly to be made we hereby bind ourselves and our heirs, executors, and administrators, and each and every of them, firmly by these presents.

Sealed with our seals, dated the day of August, one thousand eight hundred and seventy-eight.

The condition of this obligation is such that, whereas, lately, in the Circuit Court of the United States for the Eastern District of Michigan, in equity, in a cause depending in said court between Thos. Sayles, complainant, and George Hendrie, defendant, a decree was rendered against the said defendant, and the said defendant having obtained leave to remove said cause to the Supreme Court of the United States for review; now, therefore, if the said George Hendrie shall prosecute such appeal to effect and shall pay or cause to be paid to the said Thomas Sayles the amount of such
53 decree, with interest, and all damages and costs which may be awarded against him, the said George Hendrie, in case said decree shall be affirmed, then this obligation to be void, otherwise to remain in full force and virtue.

GEO. HENDRIE. [SEAL.]
SIDNEY D. MILLER. [SEAL.]

(Endorsed:) Filed Aug. 31, 1878. (Sgd.) Jno. Graves, dpy. clk.

54 EASTERN DISTRICT OF WISCONSIN, *ss.*

I, Addison Mandell, clerk of the Circuit Court of the United States for the Eastern District of Michigan, do hereby certify the above and forgoing to be true copies of the original files, records, and proceedings in the case of Thomas Sayles, complainant, against George Hendrie, defendant, including the pleadings, orders, and proceedings in said cause, on file and of record in said cause, and of the bond on appeal in said cause; that I have carefully compared the same with the originals thereof, of record and on file in my office, and the same are true copies thereof and of the whole of said original files, records, and proceedings.

In testimony whereof, I have hereunto set my hand and the seal of said court, at Detroit, this 9th day of October, A. D. 1878.

[SEAL.] ADDISON MANDELL, *Clerk.*

Clk's fees...	$11 45
Postage.....	45
	$11 90

(Endorsed on cover:) E. Michigan C. C. U. S. No. 947. George Hendrie, appellant, vs. Thomas Sayles. Filed 24th October, 1878.

Supreme Court of the United States

OCTOBER TERM, 1878.

GEORGE HENDRIE,
APPELLANT.
vs.
THOMAS SAYLES,
APPELLEE.

Appeal from Circuit Court for the Eastern District of Michigan.

ARGUMENT FOR APPELLANT.

D. BETHUNE DUFFIELD,
Counsel for Appellant.

DETROIT:
FREE PRESS BOOK AND JOB PRINTING HOUSE.
1878.

SUPREME COURT

OF THE UNITED STATES.

GEORGE HENDRIE,
Appellant.
vs.
THOMAS SAYLES,
Appellee.

Appeal from the Circuit Court of the United States for the Eastern District of Michigan. IN EQUITY.

ARGUMENT FOR APPELLANT.

The record is simply bill and demurrer.

Lafayette F. Thompson and Asahel G. Batchelder invented a railroad car brake about 1847, and applied for a patent.

Prior to the issue of a patent, on April 1, 1852, they made an assignment to Tanner, which is set ont as Schedule A, in the bill.

On July 6, 1852, the patent was issued to Tanner.

In 1854, Tanner assigned the patent to complainant, and assumed to assign any extension of the patent (Schedule D in bill).

In 1866, the patent was extended for seven years, upon the petition of Batchelder and Thompson's administrator (Schedule C).

The bill charges infringement during the extended term of the patent only.

The demurrer is on the ground that the bill shows no legal title to the extended term in the complainant.

Unless the complainant has the sole legal title to the extended term, he cannot maintain this suit.

1 Barb. Ch. Pr., 39,
1 Dan. Ch. Pr., 241.

The whole case depends upon the effect of the assignment of April 1, 1852, to Tanner.

If that assignment gave Tanner such an interest in the extended term that the legal title thereto would vest in him the moment the extension should be granted, the demurrer is bad; otherwise it is good.

There are two amendments to the bill. I will first examine the assignment, and then the amendments.

I.

This assignment is to be construed like any other contract, to carry out the intention of the parties.

Nicolson Pavement Co. v. Jenkins, 14 Wall., 456.

And to gather that intention the court may look at the situation of the parties and the surrounding circumstances.

2 Pars. on Cont., 499.
Shore v. Wilson, 9 Cl. & Fin., 555–569.
Mumford v. Getling, 7 C. B. (N. S.), 309.
Carr v. Montefiore, 5 Best & Smith, 427.

The assignment was prior to the issue of the patent. The inventors then had an inchoate right to the exclusive use of their invention, the invention being complete, and this right could be assigned so that the legal right which would result from the issue of the patent would vest in the assignee.

Gayler v. Wilder, 10 How., 493.

And they perhaps had then an inchoate right to an extension, assignable with the same effect as their right to a patent.

R. R. Co. v. Trimble, 10 Wall., 380.

The assignment is as follows:

SCHEDULE A.

Whereas, We, Lafayette F. Thompson, of Charlestown, and Asahel G. Bachelder, now or late of Lowell, in the State of Massachusetts, have invented an improved mode of operating the brakes of railway cars, and have applied, or intend to apply for letters patent of the United States of America, therefor.

Now therefore, this indenture witnesseth, that for and in consideration of one hundred dollars, in hand paid, the receipt whereof is hereby acknowledged, I have assigned and set over, and do hereby assign and sell and set over to Henry Tanner, of Buffalo, in the State of New York, all the right, title and interest whatever, which we now have, or by letters patent, would be entitled to have and possess, in the aforesaid invention; the said invention being described in the specification as prepared and executed by us, or to be prepared and executed by us, for the obtaining of said letters patent; the whole to be held and enjoyed by the said Henry Tanner and his legal representatives, to the full extent and manner in which the same would have been or could be held and enjoyed by us had this assignment never been made.

And we do by these presents, authorize the Commissioner of Patents to issue the said letters patent to the said Henry Tanner and his legal representatives, as the assignee of our whole right and title to the same and to the new invention aforesaid.

In witness whereof, we have hereunto set our signatures and seals, this first day of April, A. D. 1852.

Witness:	LAFAYETTE F. THOMPSON.	[SEAL.]
R. H. EDDY.	ASAHEL G. BATCHELDER.	[SEAL.]

The preamble of this assignment states that Thompson & Batchelder have invented an improved brake, for which they have applied, or are about to apply for letters patent.

The granting clause is in these words "all the right, title and interest which we now have, *or by letters patent would be entitled to have and possess in the aforesaid invention;* the said invention being described in the specification as prepared and executed by us, or to be prepared and executed by us, for the obtaining of *said letters patent.*"

The *habendum* clause simply refers to the granting clause.

And finally, the Commissioner of Patents is authorized to issue "*the said letters patent*" to Tanner, as the assignee of the inventor's whole right and title to *the same*, and to the new invention aforesaid.

It will be noticed that all through this assignment the words "*letters patent*" refer to the letters patent for which the preamble states that the inventors had applied or were about to apply.

It may be claimed that these words as used in line 13, do not so refer, but are intended to cover any or all letters patent. This cannot be maintained if the granting clause is read as a whole, and that is the only proper way to read it, for the last three words of that clause plainly and clearly show that the only "letters patent" covered or intended to be conveyed are those for which the grantors have applied or are about to apply.

And there can be no dispute as to what is meant by the words "letters patent" in the final clause of the assignment. The language seems clear and consistent.

The inventors sell the right we now have, or by letters

patent would be entitled to have and possess, in the *aforesaid invention.*

Is there any doubt that the "aforesaid invention" is the one described in the specification prepared or to be prepared?

And this specification is prepared, or to be prepared, "*for the obtaining of said letters patent.*" To what can this refer except to the letters patent which the inventors convey to Tanner?

The granting clause, when taken as a whole, plainly describes the invention and the letters patent intended to be conveyed, as described in and to be obtained by the specification mentioned.

And that specification was not prepared to obtain the extension.

And again, the inventors authorize the issue of "said letters patent" to Tanner, as the assignee of their "*whole right and title to the same,*" not to *any letters patent*, but to "*said letters patent.*"

Does this not clearly show that the original term was alone intended to be conveyed?

The grantors are careful not to extend the meaning which might be given to the words "letters patent," in line 13, and studiously avoid conveying "any letters patent," as in *Clum vs. Brewer*, or such letters patent "as are or may be granted," as in *R. R. Co. vs. Trimble*, and *Nicolson Pavement Co. vs. Jenkins.* They confine it strictly to the "letters patent" for which they had prepared, or were about to prepare, a specification.

I think this court has never passed directly upon the question whether an assignment of the "invention" necessarily includes both terms of a patent, or clearly shows an intention so to do.

In the case of *Wilson vs. Rousseau, 4 How, 646*, the assignment from Woodworth to Strong, p. 647, which was of "the invention," or "improved method," and made prior to the

issue of the patent, was regarded as not conveying the extension, and the deed between the owners of the Woodworth and Emmons patents, although it provided that the renewal of either patent should enure to the benefit of the respective parties, was held not to carry the extension.

The case of the *Nicolson Pavement Co. vs. Jenkins* seems to assume that a sale of the "invention" does not necessarily convey both terms.

This point has, however, been decided in two cases in the Circuit Courts,

Clum v. Brewer, 2 Curtis, 520.
Waterman v. Wallace, 13 Blatch., 132,

And both these cases hold that the term "invention" does not necessarily include both terms.

And in *Gayler vs. Wilder, 10 How., 477*, the assignment from Fitzgerald was in language very nearly like that of this assignment, and was certainly as broad as this assignment. This court held in that case that the legal title to the original patent passed, because the language used appeared to be intended to operate upon a *future legal interest*, as well as upon the imperfect and inchoate interest which Fitzgerald then had.

So the rule seems to be, that when an inventor, prior to the issue of the patent, assigns his *invention*, and uses language which appears intended to operate upon a future legal interest, that legal interest will pass, but that no future legal interest will pass by such an assignment, unless the language used seems to be intended to operate upon such interest.

This assignment plainly names one such legal interest, and *only one*.

It will be noticed that this assignment does not specifically convey the extension, and that nowhere in it is the word "extension" used; nor is any reference made to a possible extension of the letters patent so often mentioned.

It is a well known rule of law that all contracts are presumed to be made with reference to the law as it existed at the time the contract was made.

At the date of this assignment it was well known that no patent could be granted for a longer period than fourteen years.

It was well known that such a patent might, in certain contingencies, be extended for seven years. The law of ownership of extensions had been fully discussed and settled by this court in *Wilson vs. Rousseau*; it was there held that it was the policy of the law that the extension should belong to the inventor, and not to the speculative assignee, and that even a proviso that any renewal of the patent should enure to the benefit of the assignee would not convey the extension.

It was well understood that the extension was of much more value than the original term, for the obvious reason that the use of the patented device would increase as the patent grew older, and the expense and labor of obtaining a patent and introducing the device into use would all fall upon the holder of the original term; and this was especially true in patents whose value, like the one in question, depended solely upon the use of the patented device by parties other than the inventor.

Certainly one party to that assignment, Henry Tanner, knew how to word an assignment so that it would include an extension, for his assignment to complainant is clear and explicit, and was made long before this court had declared the legal effect of such an assignment, in *R. R. Co. vs. Trimble, 10 Wall., 377.*

Tanner bought this patent "as a matter of business and speculation."

Had he supposed that he was buying the most valuable part of the patent, the extension, can there be any doubt that he would have been careful to see that it was included *eo nomine?*

Does not the failure to name or refer to the extension—nay more, the studied care with which all mention of the extension is avoided—show conclusively that the assignors did not intend to convey the extension to Tanner, and that Tanner intended to buy only the original term?

The mere nominal consideration strengthens this view. The inventors may have been willing to sell the original term for a small sum, *plus* the labor and expense of obtaining the patent and introducing the device into use, but it is absurd to say that they would thus part with the extension also.

I submit, therefore, that this assignment does not show any intention on the part of the grantors to convey to Tanner their rights in the extension, but that it clearly shows that they did *not* intend so to do.

Judge Benedict has analyzed this assignment much more ably than I can hope to do, and I respectfully ask that his reasoning, reported in *5 Fish. Pat. Cases, 587*, may be treated as a part of this argument.

II.

The complainant seeks to strengthen his bill by two amendments.

The first sets up an agreement by which Tanner was to give Thompson & Batchelder a certain proportion of the amount realized by him from the patent, after making certain deductions.

This amendment is to meet the view that no extension of the patent could be granted, if the inventors had no interest in the extension.

If such is the policy of the law, then the bill shows that no valid extension of this patent could have been granted, for Tanner in 1854 assumed to sell the extension to Sayles, and

the inventors had no such equitable interest in the extension as did the inventor in the case of *Gear vs. Grosvenor, 6 Fish, 320.*

By that assignment, if valid, their interest in the extension or its proceeds became utterly lost, and the extension was simply for the benefit of the assignee.

The second amendment sets up that Thompson & Batchelder and Tanner by their subsequent acts practically construed this assignment as passing the extension to Tanner.

The first objection is, that it is not well pleaded. It does not set up facts, but avers conclusions. It is a well established rule of pleading that facts alone must always be pleaded, except in the single case of deeds or other instruments, where the legal effect of the deeds may be stated.

1 Chitty's Pleadings, 539.

The amendment is therefore bad, and does not help the bill.

But even if it is well pleaded it does not help the bill.

As was well said by Shipman, J., in *Waterman vs. Wallace, 13 Blatch., 132*, the acts or declarations of Tanner (Keller) could not affect or enlarge the scope of this assignment.

And unless the meaning of the assignment is doubtful, the acts or suppositions of the parties are entitled to no weight. They can only be resorted to where the meaning is ambiguous.

R. R. Co. v. Trimble, 10 Wall., 377.

The meaning of this assignment is clear, and beyond that there is no language in it which can cover more than one future interest, and that interest is clearly the first term of the patent. So the acts or construction of the parties are immaterial.

D. BETHUNE DUFFIELD,
Counsel for Appellant.

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1878.

GEORGE HENDRIE

vs.

THOMAS SAYLES.

ARGUMENT FOR APPELLEE,

BY

ALBERT H. WALKER.

CHICAGO:

Gulbert & Chesold, Printers.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1878.

GEORGE HENDRIE, APPELLANT,
vs.
THOMAS SAYLES, APPELLEE.
No. 947.

STATEMENT OF THE CASE.

Thomas Sayles filed a bill in equity against George Hendrie, in the court below, on the 15th day of August, 1876, stating that Hendrie had infringed his rights under letters-patent of the United States for an improvement in railroad car brakes, granted to Henry Tanner, July 6, 1852; by using the brakes in the State of Michigan, during the extended term of the patent. Hendrie appeared by counsel, in September, 1876, but no answer had been filed prior to February 13th, 1877, when Sayles filed an amended bill for the same cause of action, and praying for an account of profits, and for general relief. To this amended bill, the letters-patent and the certificate of extension of the same, were annexed as Schedules B, and C, (record, pp. 12 and 17,) and the assignment of April 1, 1852, under which Tanner obtained title from Thompson and Bachelder, the inventors, was annexed as Schedule A, (p. 11) and the assignment of July 13, 1854, under which Sayles obtained title from Tanner, was annexed as Schedule D (p. 18).

The amended bill was afterward amended by the insertion of two additional paragraphs (p. 23, folio 40), and to the amended bill as amended, the defendant filed a demurrer (p. 24, folio 42) raising the single question of the complainant's title to the extended term of the patent. He could properly do this,

because the two assignments, upon which that title rests, were set forth verbatim as Schedules attached to the amended bill.

The demurrer was fully argued before Judge Brown, in July, 1878, and after being held under advisement by him for some weeks, was overruled. Thereupon the defendant elected to stand by his demurrer, and accordingly the bill was taken *pro confesso* as for want of an answer; and a final decree was rendered, from which the defendant appealed to this court, where the single question of title therefore arises for review.

A reading of the assignment of Tanner to Sayles (p. 18) will show that both the first and any extended term of the patent were thereby explicitly granted to Sayles, throughout all of the territory of the United States, except Ohio, Indiana, and Illinois, and except those parts of the United States occupied by about forty railroads therein named. No fault, therefore, can be found with Sayles' title to the extended term, in the City of Detroit, where Hendrie infringed, unless it be made to appear, that in selling it to Sayles, Tanner assumed to convey what he did not own.

We agree, therefore, with the appellant in saying (p. 2 of Mr. Duffield's brief, line 7): "The whole case depends upon the effect of the assignment of April 1, 1852, to Tanner."

THE QUESTION IN THE CASE.

Did the assignment of April 1, 1852, *convey the inchoate legal title to the extended term of the letters-patent, which were afterward granted, and afterward extended.*

APPELLEE'S ARGUMENT.

The assignment must be construed in the light of the five following clear and undisputable propositions of patent law.

First: "The discoverer of a new and useful improvement is vested by law with an inchoate right to its exclusive use, which he may perfect and make absolute by proceeding in the manner which the law requires."

Gayler v. Wilder, 10 Howard 493 (1850).

Second: "The inventor has not only an incohate right to obtain letters patent securing him the exclusive right to his invention for the term of fourteen years, but also a further inchoate right to have the term extended, provided he shall fail, without fault, to obtain a reasonable remuneration for the time, ingenuity, and expense bestowed on the same, and the introduction thereof into public use."

Curtis, J., in Clum v. Brewer, 2 Curtis 520 (1855).

Third: The first of these incohate rights is capable of assignment *while incohate*, and such assignment operates to vest in the assignee the legal title to the first term of a patent, the moment the letters-patent are issued.

Gayler v. Wilder, 10 Howard 493 (1850).

Fourth: The inchoate right to an extension of a patent is also assignable *while inchoate.*

Wilson v. Rousseau, 4 Howard 679 (1846).

Nicholson Pavement Co. v. Jenkins, 14 Wallace 456 (1872).

Fifth: An assignment of this last inchoate right, equally with an assignment of the inchoate right to the first term, operates to vest the legal title in the assignee, the moment the patent is extended.

Railroad Company v. Trimble, 10 Wallace 380 (1870).

It appears from the bill of complaint, that on the 1st day of April, 1852, Thompson and Bachelder were vested by law with *both* the inchoate rights, of which mention has been made; i. e., the inchoate right to the *first term*, and the inchoate right to *any extension* of such letters-patent as should be obtained for their invention.

It follows from the authorities above quoted, that any assignment they might make on that day, of their interest in either or both of said terms, would operate to convey the *legal* title thereto respectively, as soon as those terms respectively should be granted.

The assignment they did execute to Tanner on that day, of course, conveyed the *first* of these incohate rights; the only question being whether it did or did not also convey the *second*.

The pivotal language of the instrument is as follows: "Have assigned and set over, and do hereby assign, sell, and set over, all the right, title, and interest whatever which we now have, in the aforesaid invention."

Our first and second authorities establish the fact that Thompson and Bachelder had, prior to April 1st, 1852, two inchoate rights or interests in their invention. As the assignment conveyed *all* the right and interest *whatever* which they then had, it hardly requires argument to show that *both* of the inchoate rights in question were conveyed thereby. Indeed this point, as it arose in a copyright case, has received the express adjudication of Lord Chancellor Thurlow. In the case of Carnan v. Bowles, 2 Brown's Chancery, Rep. 67 (1786), the Lord Chancellor said: "The contingent interest (in the extension of a copyright) must pass by the word '*interest*' in the grant. He conveys all his interest in the copyright: the assignment must have been made on the idea of a perpetuity; and it is probable not a syllable was said or thought of respecting the contingent right. If he had meant to convey his first term only, he should have said so."

It is true that Judge Curtis in the case of Clum v. Brewer, thought that he saw a distinction between the extension of the copyright upon which Lord Thurlow passed, and the extension of a patent under our law, and therefore did not follow Lord Thurlow's decision. Judge Curtis said that distinction consisted in the three-fold circumstance, that the extension of a patent was contingent, was exclusively personal to the inventor, and only he or his personal representatives could obtain it.

If Judge Curtis had examined the English statute, by virtue of which extensions of copyrights could be enjoyed in the time of Lord Thurlow, he would have found that in that case also, the extension of a copyright was contingent; was personal to the author; and not only could be obtained by nobody other than the author or his personal representatives, but could be obtained by nobody but the author *in person*. He obtained it simply by *living*.

The statute to which I refer was 8 Anne, Chap. 19, Sec. 11 (1709): "Provided always, That after the expiration of the said term of fourteen years, the sole right of printing or disposing of copies shall return to the authors thereof, if they are then living, for another term of fourteen years."

Moreover, this Court held, in the case of Railroad Company v. Trimble, 10 Wallace (1870), that there is no substantial ground of distinction between the assignability of the inchoate right to a first term, and of the like right to

an extension. It was only because he *thought* he saw a distinction, that Judge Curtis said that the sale of the invention did not necessarily carry the extension. With profound respect for that eminent jurist, I still ask this Court to consider whether *all* rights, under the invention, do not include the rights under an extension, precisely as the greater must always include the less.

Judge Curtis himself remarked, in this very case of Clum v. Brewer, that where the invention was the thing sold, it would be natural to look for additional words that *would* be sufficient to convey the extension. Indeed, he found such words in the very instrument under consideration, and they were "rights and property that I may have from any Letters Patent for the same," differing from our assignment only in the insertion of the word "any," which in ours, is *understood*, as appears from the fact that the conveyance is of "*all* the right, title, and interest *whatever*, which we, by Letters Patent would be entitled to have and possess." The term "Letters Patent" is here used *generically*, and refers not to any particular Letters Patent, and much less to any particular term of a single Letters Patent. *All* the rights *whatever* that Bachelder and Thompson would (might) have and possess, by (i. e. by means of) Letters Patent, necessarily include their entire possible monopoly; whether created by a single Letters Patent or by many, or whether issued by one government or by many, and *a fortiori* whether arising from a single Letters Patent *after* or *before* its extension.

There was indeed no actual necessity for the insertion of the words "or by Letters Patent would be entitled to have and possess." They simply indicate that the distinction between the *incohate* rights then in existence, and the *legal* rights that would result from the actual existence of a protected monopoly, was understood; and that Bachelder and Thompson intended to use language that should, beyond cavil, convey those *legal* rights as soon as they should come into existence, not contenting themselves with language that purported to convey only their equitable incohate interests. In the case of Gayler vs. Wilder, this Court, however, held such prospective words to be *unnecessary*, saying: 'When the party has acquired an incohate right to it, and the power to make that right perfect and absolute at his pleasure, the assignment of his whole interest, whether executed before or after the patent issued, is equally within the provisions of the act of Congress;" referring to Sec. 11 of the act of 1836.

A superficial examination of the instrument might possibly suggest that the expression "Letters Patent" in the granting clause, which I have said is a *generic* one, is not so in fact, but is subsequently in the instrument, designated to mean the *particular* Letters Patent, for the obtaining of which, the specifi-

cation had been or was about to be prepared and executed, and which the Commissioner of Patents was authorized to issue to Tanner.

That it is *not* so designated clearly appears, however, on a more careful reading, because such reading will show that the expression "said Letters Patent," for the obtaining of which, the specification had been prepared and executed, or was to be prepared and executed, refers for its antecedent to the "Letters Patent of the United States of America," for which the *preamble* states Thompson and Bachelder had applied or intended to apply.

With equal certainty it appears that the expression "the said Letters Patent," which the instrument authorized the Commissioner of Patents to issue to Tanner, also refers for its antecedent to the "Letters Patent of the United States of America," for which Thompson and Bachelder had applied or intended to apply.

Neither the expression "said Letters Patent" nor "the said Letters Patent" has any *necessary connection* with the expression "Letters Patent" in the *granting clause*, and therefore will not be held to limit or define it.

Even, however, if contrary to my firm expectation, it should be thought that I am wrong on this point, and that the term "Letters Patent" in the granting clause refers only to the particular Letters Patent, for which Thompson and Bachelder had applied or were about to apply, and which they authorized the Commissioner to issue to Tanner; the legal meaning and effect of the *assignment* would in no manner be limited or modified by those words. Such a construction would merely show that having by the pivotal words of the instrument, conveyed *both* their *inchoate* rights, Thompson and Bachelder superadded thereto, language describing only *one* future *legal* title, leaving the other legal title to vest *without* such superadded language. In other words, they did only *one* unnecessary thing, instead of doing *two*. That I am right in this view, and that the right to "the said Letters Patent" which the commissioner was authorized to issue to Tanner, was not the entire subject of the assignment, *further* appears from the care with which it was recited that Tanner was the assignee not only of the whole right and title to the same, but also to the new *invention* aforesaid.

Our assignment is also, at *least* as broad as the Trimble assignment, which was held by this Court to convey the extension. 10 Wallace 380 (1870).

The granting part of the Trimble Assignment, and its habendum, read in connection with each other are (omitting uncontrolling words) as follows: "assign, sell, and set over, all the right, title, and interest which I have in said invention, *as* secured to me by *said* Letters Patent; the same to be held and enjoyed, *to the full end of the term for which said Letters Patent are*

or may be granted, as fully and entirely as the same would have been held and enjoyed by me had this asssignment and sale not have been made."

The Tanner Assignment is in its same parts as follows: "assign, sell, and set over, all the right, title, and interest whatever, which we now have, *or by Letters Patent would be entitled to have and possess*, in the aforesaid invention; the whole to be held and enjoyed, *to the full extent* and manner in which the same would have been or could be held and enjoyed by us had this assignment never been made."

To what "full extent" could the whole (invention) be *held* and *enjoyed* by Bachelder and Thompson, had this assignment never been made? Obviously, "to the full end of the term for which Letters Patent were or might be granted."

Moreover, not only the "invention," but also "all the right, title, and interest whatever, Bachelder and Thompson by Letters Patent would be entitled to have and possess" therein, was to be held and enjoyed by Tanner, to the full "extent" in which the same could be held and enjoyed by them, had this assignment never been made. To what "*extent*" could that right, title, and interest thus be held? *Certainly*, to the *extent* of fourteen years, and *contingently* to the *extent* of an *extension* thereof for seven years more.

The generic language in our assignment, viz.: "or by Letters Patent would be entitled to have and possess," which is wholly absent from the Trimble assignment, is alone more than equivalent in force to the controlling words in the latter, viz.: "to the full end of the term for which *said* Letters Patent are or may be granted;" inasmuch as the latter includes only every possible *American* monopoly; while the former includes every possible monopoly anywhere in the world.

I will also call attention to the fact that our construction of the assignment gives a reasonable meaning to every word in it, while on the other hand, to construe it *not* to convey the extension, one must wholly ignore the following language in it, viz.: "now have, or" in the granting clause, and also, "and to the new invention aforesaid," at the very close of the instrument.

But even this is not enough for that purpose. The assignment would *still* convey the extension. To make it do otherwise, the words, "the issuing of said" must be *inserted* immediately before the term "Letters Patent" in the granting clause.

By no smaller mutilation of the instrument than the leaving out of the above nine words, and the insertion of the four, could the conveyance be confined to the first term of the patent.

This consideration is *alone* sufficient to necessitate our construction of the

assignment, for the Supreme Court, in the case of the Nicholson Pavement Co. v. Jenkins, 14 Wallace 456 (1872), held that, "In constructing a contract, effect, if possible, is to be given to every part of it, in order to ascertain the meaning of the parties to it." That is precisely what by *our* construction is done, and precisely what *cannot* be done by those who would insist that the assignment did not convey the inchoate legal right to the extension in question.

The decision of this court in the case of Nicholson Pavement Co. v. Jenkins, is, in the opinion of Judge *Shepley*, alone conclusive of such a question as the one at bar. In referring to that case he said: "The law must, therefore, be considered as settled by this decision, that whenever a patentee conveys his 'invention,' without any other language in the deed of conveyance restricting the right to use the invention by a limitation of time or place, he must be considered to have granted the right to *any* Letters Patent which may be issued thereon."

Emmons v. Sladdin; IX Of. Gaz. of Pat. Off., 354 (1875).

If the assignment were *ambiguous*, I would call attention to the well known principle, that doubts arising on assignments, must be resolved against the *grantors*.

This principle was applied to a patent case by Nelson, J., in Smith v. Selden, 1 Fisher's Pat. Rep., 303 (1849). He says: "Even in the case of well founded doubt, perhaps the conclusion should be against the parties who have made the grant, as they are chargeable with any obscurity in this respect in the agreement."

It is stated in the amendment to the bill in this case, also, that all the parties to the instrument, by their *acts*, did practically construe it soon after it was executed, and that they so construed it to convey any extension of the letters-patent, and on demurrer this statement must be taken to be true. This circumstanee alone is sufficient to control, if the assignment is ambiguous. It is stated in the case of Railroad Co. v. Trimble, 10 Wallace, 377, "Where there is a doubt as to the proper construction of an instrument, this feature of the case is entitled to great consideration." To the same effect it was held in Rubber Co. v. Goodyear, 9 Wallace, 799 (1869), that "The practical construction which the parties themselves have given to a contract, by their conduct, is in cases of doubt, always entitled to great weight."

Comments on Mr. Duffield's Argument.

I. The appellant, on page 4, line 8, of Mr. Duffield's brief, says that the granting clause of the assignment is, in these words, "*all the right, title and interest whatever, which we now have, or by Letters Patent would be entitled to have and possess in the aforesaid invention;* the said invention being described in the specification as prepared and executed by us, or to be prepared and executed by us, for the obtaining of said letters-patent;"

I submit to the court, that the granting clause includes only the words I have *italicised* above, and that the additional language Mr. Duffield assigns to the granting clause, is merely matter of *recital*, introduced for the purpose of identifying, with unusual care, the *invention* conveyed. To say that this matter of recital *limits* the conveyance, is equivalent to saying that a deed, purporting to convey a fee simple in certain lands, to A. B., and reciting that the lands in question are those of which C. D. now holds a lease for fourteen years, is, by such recital, limited to a term for years.

II. Mr. Duffield says (p. 4, line 19), "It will be noticed that all through this assignment, the words "*letters-patent*" refer to the letters-patent for which the the preamble states the inventors had applied, or were about to apply."

Now, the words "letters-patent" occur four times in the assignment. In the *first*, *third*, and *fourth* instances, they *do* explicitly refer to the *particular* letters-patent indicated by Mr. Duffield. In the *second* instance, however, i. e., in the *granting clause*, this explicit reference to the *particular* letters-patent is carefully omitted, and the *generic* term, "letters-patent," is employed instead. Whenever the *particular* letters-patent are referred to, they are elaborately *described*, but there is nothing to indicate that the expression "letters-patent" in the granting clause, refers to those *particular* letters-patent *only*. It is true that, in the *third* and *fourth* instances in which the words "letters-patent" are used, they have the *narrow* signification, and that they are preceded by the relative word "said," thus showing that somewhere in the instrument they have an antecedent, *likewise* narrow. If the words "letters-patent" in the granting clause *are* that antecedent, then doubtless *they* are narrow; but if they are *not* narrow, then the relative words go one step further back, and find a perfect antecedent in the particular letters-patent described in the *preamble*. I do not deny that the relative words "said" must refer to the *first* preceding antecedent; but I insist that they must refer to the first preceding *antecedent*. The expression "letters-patent" in the

granting clause cannot be that antecedent, unless it is *narrow;* and it cannot be *narrow* unless it is that antecedent. The reasoning that makes the relative word refer back to *it*, is reasoning in a circle, and therefore no reasoning. I deny that the generic expression, "letters-patent," is either *narrow*, or is the *antecedent* of the word "said." He who would attempt to prove that it is *narrow*, must *assume* that it is the *antecedent* of "said;" and he who tries to show that it is the *antecedent*, can do so only by *assuming* that it is *narrow*. Neither of these assumptions can be allowed, and therefore the expression, "letters-patent," in the granting clause, must be defined by itself; and when so defined, it doubtless refers to "letters-patent" in *general*—to those grants of governments known as "letters-patent"—to *any* letters-patent.

III. Mr. Duffield says (p. 5, line 15): "And again the inventors authorize the issue of 'said letters-patent' to Tanner, as the assignee of their 'whole right and title to the same;' not to any letters-patent, but to 'said letters-patent.' Does not this clearly show that the original term was alone intended to be conveyed?"

I answer, that it merely shows that the original term was alone, by that *paper*, authorized to be *issued*. The *issue* of the extension *could not* be authorized at *that time*, and therefore no such attempt was made. Moreover, Mr. Duffield will find a complete answer to his question in the *rest* of the sentence which he partly quotes. That sentence recites that Tanner is the assignee "of our whole right and title to the same [said letters-patent], *and to the new invention aforesaid.* These last words are meaningless, if the "said" letters-patent, for which the inventors had applied or intended to apply, constituted the *only* subject matter of the assignment.

IV. The case of Wilson v. Rousseau is quite foreign to the case at bar, because at the time the assignment therein construed was executed (1828), the inventor had no inchoate right to an extension, there being, in the language of the Supreme Court (p. 685), "no provision in the patent laws, authorizing an extension or renewal of a patent beyond the original term of fourteen years." The court of course held that an assignment of all Woodworth's interest in his invention included only the interests he then had, and did not include interests created by subsequent laws.

V. Judge Shepley, in Emmons vs. Sladdin, IX Official Gazette of the Patent Office, 354 (1875), took precisely the opposite view of the case of The Nicholson Pavement Co. v. Jenkins, from that taken by Mr. Duffield.

VI. In the case of Waterman v. Wallace, it was not the *invention* that was conveyed, but such rights *in* the invention as were secured by a particular re-issued letters-patent, the exact language being, "do hereby assign, sell, and set over, in trust, all my right, title and interest, of, in, and to the *aforesaid* re-issued letters-patent, and the invention *thereby* secured," i. e. rights secured in the invention, by the *aforesaid* re-issued letters-patent.

VII. Mr. Duffield says (p. 6, line 16): "This court held, in Gayler v. Wilder, that the legal title to the original patent passed, *because* the language used, appeared to be intended to operate upon a *future legal* interest, as well as upon the *inchoate* interest."

As I read the case, no such "because" is to be found in it. The court did indeed incidently remark that the assignment *contained* such language, but it did not base its decision on that fact. On the contrary, it said that the assignment of the inchoate interest, and of the perfected legal title, were *equally* within the act of Congress providing for assignments. It did not hint that the inchoate interest could *only* be assigned by language that describes a future legal title. The court held that the *assignment* of the whole interest *conveyed* the whole interest, notwithstanding the *character* of that interest, changed from *inchoate* to *absolute* after the date of the assignment.

VIII. Mr. Duffield says (p. 7, line 15): "It was well understood that the extension was of much more value than the original term." And he argues that, therefore, if it was intended to be conveyed, it would have been particularly *named*. The premises here are entirely mistaken. The first term was twice as long as the extension, and was *certain*, while the extension was *contingent*. Moreover, the extension is just as much named in the granting clause as the first term is. Both are included under the language, "all right, title, and interest whatever," in the "invention," and in "letters-patent." Rights under an extension are just as truly rights under "letters-patent" as rights under an original term are. Whenever, in this paper, the original letters-patent are mentioned, it is by way of *recital* only, and not by way of *grant*.

IX. The "mere nominal consideration" written into the paper, does *not* strengthen the appellant's argument, because it was not the *real* consideration. Parol evidence of the real consideration is of course admissible, and accordingly our first amendment to the amended bill (p. 23, line 2 from bottom) states that the whole of the real consideration consisted of an agreement by Tanner to pay to the inventors one-half the net proceeds of *all* his sales of rights to make, use, or vend the invention.

X. Mr. Duffield asks that Judge Benedict's decision in 5 Fisher, be treated as a part of his argument. In addition to the points Mr. Duffield has himself presented, that opinion seems to contain but one argument, and the substance of it is as follows: "It is highly improbable that the right to the extension, was intended to be conveyed from the inventors to Tanner, because no extension could ever be obtained from the Patent Office, unless the inventors were to be benefited thereby, which they would not be, if Tanner owned the entire interest therein." There are several answers to this argument, which, having proved satisfactory to four Judges on the Circuit, I will now submit to this Court.

A. The question is not, what, in the exercise of wisdom, the parties *would* have done. The question is, what *did* they do.

B. The conveyance of the extension to Tanner would *not* prevent the obtaining of the extension from the government, because Tanner could, at any time prior to the application for the extension, *re-convey* to the inventors, some legal or equitable interest therein, either of which would be sufficient to support the extension. Several instances of this plan of entire conveyance, and partial re-conveyance, may be found in the records of the Patent Office.

C. In *this* case, however, the inventors *retained* an interest in the proceeds of the invention, by means of a contemporaneous written agreement, executed by Tanner to them, which provided that Tanner should pay them one-half of the net proceeds of all his sales of rights to practice the invention (p. 23, folio 40). This interest in proceeds, without any legal title, is sufficient to support an extension. See Shepley, J., in Gear v. Grosvenor, 6 Fisher's Pat. Cases 320 (1873).

The Court says: "The act of Congress authorizing extension of patents, undoubtedly contemplated a benefit to the patentee [inventor,] not yet sufficiently rewarded by the receipts from his patent. The policy of the law would seem to require, that the patentee [inventor,] applying for the extension, should himself have an interest. An equitable interest is sufficient for the purpose, the Court having decided that he may convey the legal interest [referring to the Trimble case above cited.] Such an interest the patentee in this case had by virtue of the stipulations between himself and his grantee, that he should be interested to the extent of one-half of the proceeds from sales, or use of the patented invention."

The existence of this contemporaneous agreement, was wholly unknown to Judge Benedict when he rendered his decision; neither of the parties in this case having been parties to that. and no allusion to this agreement having been incorporated into the record before his Honor. Had all the facts of the case been before the Court at that time, there is no reason to doubt that the decision would have been identical with all the decisions that have since been rendered.

XI. Mr. Duffield attempts to meet this matter of the contemporaneous agreement, by saying, that by the assignment from Tanner to Sayles, the extension was conveyed away from Tanner, if he owned it, and that thereupon the equitable interest of the inventors became entirely lost. Mr. Duffield could not have observed that the assignment to Sayles is a mere grant of a *portion* of the United States; Tanner retaining in himself three of the very best States, and over forty large railroads, upon which the contemporaneous agreement continued to operate, and in which it continued to confer very valuable interests upon the inventors.

XII. Mr. Duffield criticises the second amendment to the amended bill, which has reference to the *acts* of the parties, practically construing the assignment. He says it is not well pleaded, because he says it avers conclusions, and not facts. I understand the rule to be, that conclusions of *law* cannot be pleaded, but that, at least in equity pleading, conclusions of *fact*, or rather *allegations* of fact sufficiently broad to cover numerous details, are not only allowed, but are encouraged by the courts in order to avoid prolixity. Such *general* allegation of *fact* was especially necessary in this case, because the acts referred to, were more than fifty in number. To set them forth in detail, would have swollen the bill to an enormous bulk.

XIII. Mr. Duffield says, moreover, that even if well pleaded, the acts of *Tanner* cannot affect the scope of the assignment. This would, no doubt, be true, if the acts of Tanner stood *alone*. Inasmuch as *all* the parties to the assignment, practically construed it, and construed it *alike*, a different rule prevails. If A. B. conveys to C. D. a part of his farm by meets and bounds, and the discription of the boundary line in the deed is ambiguous, the acts of C. D. *alone*, giving it the construction most favorable to himself, are of course inadmissable. But if both grantor and grantee build a dividing fence on the line most favorable to the grantee, or if by independent acts, they *both* treat that as the true line, those acts are eagerly seized upon by courts, as conclusive evidence of the intended meaning of the ambiguous deed.

XIV. If, however, as Mr. Duffield insists, the assignment is *clearly limited* to the first term, I agree with him that the acts of the parties cannot reverse its meaning. In that event my client must lose that which he honestly bought, because of the failure of his grantor's title. If, as I insist, *the assignment clearly conveys the extension*, the *acts* are alike inadmissable and *unnecessary*. If, contrary to my belief, the Court finds the paper *ambiguous*, the acts of the parties construing it must decide the issue, and in so doing will secure to my client that which he has purchased.

The exact question at bar was, on precisely similar pleadings, decided in favor of my client by Judges DILLON and LOVE sitting together, in February, 1878, and again by Mr. Justice HARLAN in October, 1878.

ALBERT H. WALKER,
FOR THE APPELLEE.